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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ice-Pak, Inc.

Serial No. 75/232,128

James E. Shlesinger and Glen L. Gross of Shlesinger,
Arkwright & Garvey for applicant.

John E. Michos, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Walters and McLeod, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Ice-Pak, Inc. filed a trademark application to register on the Principal Register the proposed mark ICE-PAK/HOT-PAK for "reusable ice substitutes and reheatable gel packs for maintenance of temperature and other therapeutic uses."¹ Following an initial refusal to register on the ground that the proposed mark is merely descriptive in connection with the identified goods,

¹ Serial No. 75/232,128, in International Class 10, filed January 27, 1997, based on use of the mark in commerce, alleging first use and use in commerce as of March, 1996.

applicant amended its application to seek registration on the Supplemental Register.

The Trademark Examining Attorney has issued a final refusal to register, under Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that applicant's proposed mark is incapable of identifying and distinguishing its goods, *i.e.*, that ICE-PAK/HOT-PAK is a generic name for the identified goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to

that category or class of goods? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Examining Attorney contends that the category or class of goods involved herein is "therapeutic products in the nature of gel packs which may be heated or frozen and are applied to the body to provide heat or cold to treat aches, pains, and the likes"; that goods referred to as "ice packs" and/or "hot packs" include "cushions, supports, ice substitutes, gels, pads and bags"; and that applicant's identified goods "are precisely the type of therapeutic product which falls into that category of devices known as ice packs and hot packs."

The Examining Attorney contends, further, that "pak" is phonetically identical to "pack" and, thus, applicant's mark is essentially identical to "ice-pack/hot-pack"; and that "ICE-PAK/HOT-PAK is the generic name for a category or genus of goods which includes applicant's reusable ice substitutes and reheatable gel packs for maintenance of temperature and other therapeutic uses."

In support of his position, the Examining Attorney submitted excerpts of definitions from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) of "ice pack" as "1. A floating mass of compacted ice

fragments. 2. A folded sac filled with crushed ice and applied to sore or swollen parts of the body to reduce pain and inflammation"; and of "pack" as "7. *Medicine* a. The swathing of a patient or body part in hot, cold, wet, or dry materials, such as cloth towels, sheets, or blankets. b. The materials so used. c. A material, such as gauze, that is therapeutically inserted into a body cavity or wound; packing. 8. An ice pack; an ice bag."

Additionally, the Examining Attorney submitted a substantial number of excerpts from articles in the LEXIS/NEXIS database demonstrating use of the terms "ice pack" and/or "hot pack" to indicate goods as defined and described herein; and copies of Internet Web pages of manufacturers of therapeutic gel products, referring to products that, like applicant's products, may deliver either heat or cold and are called, for example, "a reusable ice and hot gel pack," "Hot/Cold Cell Pack Sheets," "Ice & Hot Pack," and "Rapid Relief Hot/Cold Pack."

Applicant argues that the Examining Attorney has not sustained his burden of proof. Applicant contends that the evidence does not show any generic use of its specific mark, ICE-PAK/HOT-PAK; that the dictionary definitions do not show a common understanding of applicant's specific designation; and that its unitary mark would be perceived

differently than its individual components and, thus, is not generic. Applicant concedes that the individual terms "hot pack" and "cold pack" are generic.²

It is clear from the record, and applicant does not dispute, that the terms "ice pack" and "hot pack" are generic for a category of, as the Examining Attorney states, "therapeutic products in the nature of gel packs which may be heated or frozen and are applied to the body to provide heat or cold to treat aches, pains, and the likes"; and that the term "pak" is phonetically equivalent to the term "pack."

Further, the record establishes that a single product may provide either heat or cold, and that such products are referred to using both terms, "ice pack" and "hot pack," in combination. Although the specific manner in which these terms are combined varies according to the article or Internet Web page in this record, each combination names

² Applicant states: "The Examining Attorney asserts that Applicant's mark is generic because Applicant has merely combined the equivalent of the two generic names, ice pack and hot pack. The connotation of Applicant's entire mark is more than the simple sum of its parts." [Applicant's brief, p. 8.]; and "[T]he Lexis/Nexis evidence submitted by the Examining Attorney may suffice to render the term 'Hot Pack' as a common generic term but the evidence is devoid of genericness with respect to the designation 'Ice-Pak.' Moreover, the combination separated with the '/' provides sufficient trademark recognition to the mark in its entirety." [Applicant's Response of April 6, 1998, p. 1. The Examining Attorney subsequently submitted evidence regarding use of the term "ice pack."]

the goods because it uses the generic noun "pack" modified by the terms "ice" or "cold" and "heat" or "hot."

In applicant's proposed mark, hyphens connect the terms "ice" and "hot" to the term "pak"; and the terms "ice-pak" and "hot-pak" are separated by a virgule ("/"). *The American Heritage Dictionary* (2nd college edition, 1985) defines "virgule" in pertinent part as "*n. Printing. A diagonal mark (/) used esp. to separate alternatives, as in and/or*" We take judicial notice of this definition. Applicant argues at length in its brief about the various ways in which the consumer may dissect this term; however, we find applicant's arguments unpersuasive. Rather, it is reasonable to conclude that a prospective purchaser is likely to understand the term, "ICE-PAK/HOT-PAK" as naming the identified product, which may be, alternatively, an "ice-pak" or a "hot-pak." We agree with applicant that its proposed mark is a unitary compound mark. We disagree with applicant's conclusion that this term is something more than its individual parts. The substantial LEXIS/NEXIS evidence and excerpts of Internet Web pages support the conclusion that purchasers and prospective purchasers understand the term ICE-PAK/HOT-PAK as referring to the category of goods.

We note that applicant's use of hyphens, a virgule and a misspelling do not require a contrary conclusion. An applicant should not be able to obtain a registration for a generic term merely by using a misspelling, or by omitting or adding punctuation marks ("/" or "-"). See, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Sec. 12:38 (4th ed. 1997). Similarly, the mere fact that the combination of these terms does not appear in the evidence of record exactly as ICE-PAK/HOT-PAK does not render this term non-generic. There may be more than one "name" for a product, as is the case herein.

In conclusion, we find that ICE-PAK/HOT-PAK simply names applicant's identified goods and is, therefore, generic and incapable of registration on the Supplemental Register.

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Decision: The refusal under Section 23 of the Act is affirmed.

P. T. Hairston

C. E. Walters

L. K. McLeod
Administrative Trademark Judges,
Trademark Trial and Appeal Board